

To: JOHN CASTELLANO

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Interview Summary

Application No.

09/482,462

Applicant(s)

ANDERSEN ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

All participants (applicant, applicant's representative, PTO personnel):

(1) Donald L. Champagne, Examiner.

(3) _____

(2) John A. Castellano, Attorney.

(4) _____

Date of Interview: 20 February 2003.

Type: a) ☐ Telephonic b) ☐ Video Conference

c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____

Claim(s) discussed: 1-24.

Identification of prior art discussed: Witek et al. & NEXPO '97.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.


Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview(if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.



Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place an indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

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Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Atty. submitted the attached agenda prior to the interview. Examiner offered the following comments to each point. 1, Procedural: The MPEP defines the examiner's job. Examiner believes that the final rejection is consistent with the MPEP. Applicant is free to petition the office for redress of this or any other procedural matter. 2.a., Motivation to combine: This point was addressed at para. 7-9 of the final rejection. 2.b., Inherency: This point was addressed at para. 14 of the final rejection. 2.c., Official Notice: This point was addressed in para. 17 and 18 of the final rejection. 3, Technical: Examiner believes the Office has established a prima facie case of obviousness. The burden then shifts to applicant to show a patentable distinction. The points 2 and 3 may be appealed to the Board.

Examiner explained that appeals to the Board are a reasonable option. Examiner is aware of one recent case where the Board rendered a decision within five months.

Atty. explained an idea for amending the last three lines of claim 1, as illustrated by the attached two figures.

Atty. summarized applicant's options as follows: If applicant chooses not to amend the claims, an appeal to the Board would be appropriate. Filing a continuing application is an option if applicant amends the claims. Examiner concurred.

Examiner could not assure that a continuing application would not be finally rejected on the first action. However, examiner noted that the attached figures demonstrated a logic that would at very least warrant a detailed explanation in a rejection. If applicant were to put this level of thought into an amendment, while allowance could not assured, an equally thoughtful response would be assured.

DLG
2-20-03

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|---------------------------------|--|---|---------------------------------------|
| To: | Examiner Donald Champagne | From: | John A. Castellano |
| Fax: | 703-746-5536 | Date: | February 10, 2003 |
| Phone: | | Pages: | (including cover sheet) |
| Your Ref.: | 09/482,462 | Our Ref.: | 45900-000391/US |
| Rc: | | CC: | |
| <input type="checkbox"/> Urgent | <input checked="" type="checkbox"/> For Review | <input type="checkbox"/> Please Comment | <input type="checkbox"/> Please Reply |

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COMMENTS:

FOR DISCUSSION PURPOSES ONLY!
PLEASE DO NOT ENTER

PATENT
45900-000391/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/482,462
Filing Date: January 13, 2000
Applicant: Per Skoldager ANDERSEN et al.
Group Art Unit: 3622
Examiner: Donald CHAMPAGNE
Title: AN ADVERTISEMENT SALES AND MANAGEMENT
SYSTEM
Attorney Docket: 45900-000391/US

Outline for Personal Interview:
Expected interview duration: 30 minutes

1. Procedural

In paragraph 12, the examiner admits that he "has not correlated each claim with each portion, but believes that this identification, with the marked copy of the reference provided to applicant, is sufficient with little labor to refute the prima facie argument if it can be refuted." To "correlate each claim with each portion" of a reference or references is the examiner's job. Failure (or inability) to do should result in a patent to the applicant.

2. Legal

a. Motivation to combine references – the examiner seems to believe that if he can think of a reason why two teachings of two different prior art references can/should be combined, that is motivation. Most of the examiner's sentences that begin with or include "Because" are not followed by any citations to anything. Motivation to combine references must come from the teachings of the prior art (hence there would be a citation to a portion of one of the references), the nature of the problem being solved by the references being combined (again, there would be a citation to a portion of one of the references), or the knowledge of one of ordinary skill in the art. For this basis (knowledge of one of ordinary skill in the art), an examiner can not just wave

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his hands and say "that would be known to one of ordinary skill in the art" – he must supply declaration evidence. Further, although there are general motivations like faster, cheaper, better, which the examiner alludes to, for example, in paragraphs 6 and 8, assuming everyone of ordinary skill in every art is always trying to make things that are faster, cheaper, better, what would make him/her choose the particular parts of the particular references that the examiner has chosen?

b. Inherency - whatever an examiner asserts is inherent, MUST be present and it must ONLY be that way. For example, if claim 1 recites a three-dimensional shape with only a single diameter and a reference teaches a perfect sphere. Perfect spheres (inherently) have only a single diameter, so that reference would destroy the novelty of that claim. By definition (inherently), a perfect sphere has only a single diameter. In the present application, claim 6 recites a size of an ad, a typeface, a font, coordinates of placement of text, relative positions, colors, border, shadings, and 3-D effects. All of these characteristics are not even, by definition, required (inherent) in every ad, and all of them, certainly by definition, are not required (inherent) to be presentation elements upon which some decision is made.

c. Official Notice – the examiner seems to believe that it is notoriously well-known to determine the price of an ad based on the material, the attributes of each ad, media data, customer data, and advertising order structure. Arguably, while this may be true, this is not all dependent claim 10 recites. Dependent claim 10 also recites that the data base and the data processor of independent claim 1 determine the price of the ad. It is not notoriously well-known that the data base and the data processor of independent claim 1 (which also perform other functions) also performs the function of determining the price of an ad using the recited ad characteristics.

3. Technical

a. Placing Several Related Ads Based on Entry of a Single Advertising Order – the examiner asserts that Witek teaches a user electing whether to place an ad in print or on-line and NEXPO '97 teaches reusing content which he asserts is the same as placing several related ads based on entry of a single advertising order. In paragraph 10 of this Office Action, the examiner argues applicants haven't sufficiently convinced him reusing content and placing several related ads based on entry of a single advertising order are different. It is the examiner's job to show they are the same, not applicants' job to show they are different.

In summary, many issues seem to stem from the fact that the examiner seems to believe the applicant must prove why applicant should get a patent, instead of the examiner proving why the applicant shouldn't.

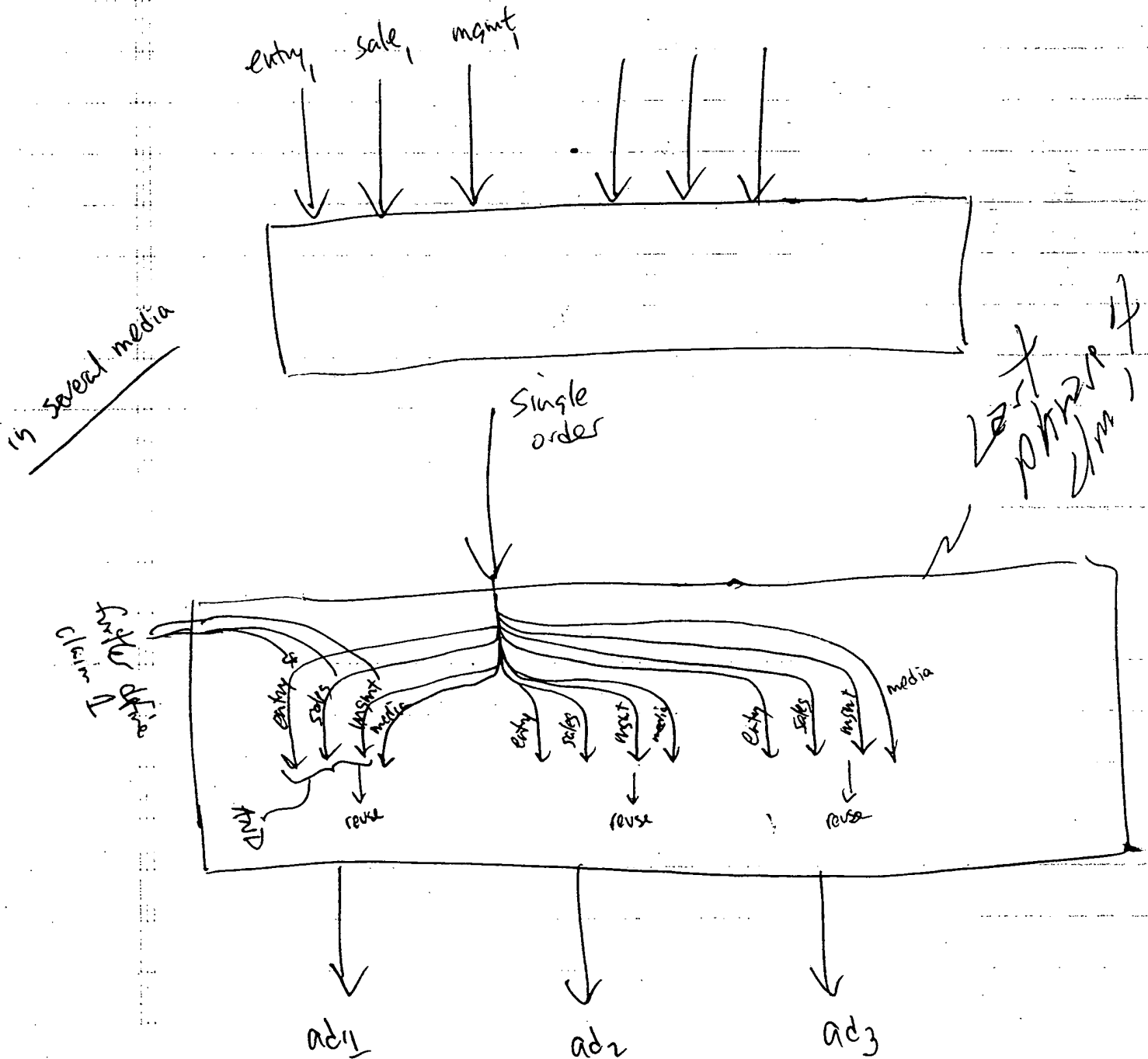
~~NERPO 97~~

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NERPO '97

reuse content

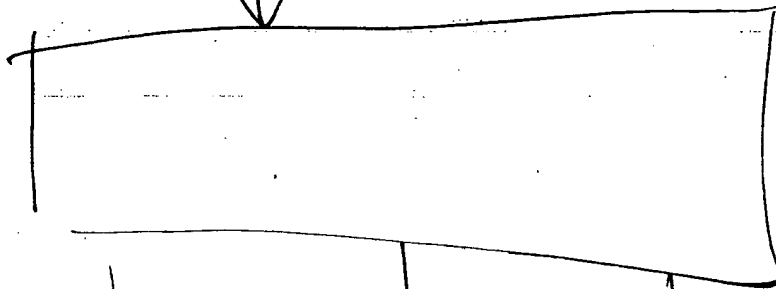
single text or picture file to more than one XPRESS layout
which makes it easier to reuse content



Nexpo / witek

reuse
content
single
(~~text~~ or
picture file)

Nexpo



ad₁ (print)
system

ad₂ (on-line)

ad₃